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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,695	08/05/2003	Shlomo Antika	CJB-0304	7570
27810	7590	10/25/2004	EXAMINER	
EXXONMOBIL RESEARCH AND ENGINEERING COMPANY P.O. BOX 900 1545 ROUTE 22 EAST ANNANDALE, NJ 08801-0900			MCAVOY, ELLEN M	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

10/634,695

Applicant(s)

ANTIKA ET AL.

Examiner

Ellen M McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Objections***

Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 1 is drawn to a method of operating and lubricating hydraulic systems at a pressure of about 4000 psi, and claim 2, which depends from claim 1, operates the hydraulic system at a pressure of about 5000 psi or higher. It is not clear how claim 2 limits the subject matter of claim 1. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Instruction Manual-5.5 HP Honda Gas Power Unit in combination with Deetman (5,464,551) and Hurst, a Material Safety Data Sheet-Hydraulic System Fluid.

Instruction Manual-5.5 HP Honda Gas Power Unit (hereinafter "Honda") discloses operating the Honda gas powered unit such as the device "Jaws of Life" at a maximum pressure of 5,000 psi with a hydraulic fluid such as a fire resistant phosphate ester fluid. The examiner is of the position that Honda meets the limitation of method claims 1-12 of operating and

lubricating hydraulic systems at a pressure of about 4000 psi (claim 1), and at a pressure of 5,000 psi or higher (claim 2) by employing as a hydraulic fluid a phosphate ester base stock.

Applicants invention differs by further specifying the phosphate ester base stock and by adding a minor effective amount of additives comprising one or more anti erosion agent(s), one or more acid scavenger(s) and one or more viscosity index improver(s). However, Deetman is added to show that such a phosphate ester base stock and additives are conventional in phosphate ester hydraulic fluids. Deetman discloses an aircraft hydraulic fluid composition which comprises a fire resistant phosphate ester base stock comprising between about 10% and about 100% by weight of a trialkyl phosphate, between about 0% and about 70% by weight of a dialkyl aryl phosphate, and from about 0% to about 25% by weight of an alkyl diaryl phosphate. The alkyl substituents of the phosphates contain between about 3 and 8 carbon atoms, preferably between 4 and 5 carbon atoms, and most preferably are isoalkyl groups such as isobutyl and isopentyl. The fluid composition additionally comprises an acid scavenger, an anti-erosion additive, a viscosity index improver, and an antioxidant. See column 2, line 26 to column 3, line 21. Hurst is added to teach that a hydraulic system fluid including triphenyl phosphate may be used as the hydraulic fluid in the device "Jaws of Life" (Honda). The examiner is of the position that the aircraft hydraulic fluid composition of Deetman clearly meets the limitations of the claimed hydraulic fluid composition as set forth by applicants in the specification on page 5. Having the prior art references before the inventors at the time the invention was made it would have been *prima facie* obvious to have employed either the phosphate ester hydraulic fluid of Deetman or the hydraulic fluid of Hurst into the hydraulic system of Honda.

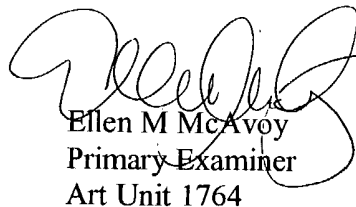
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The terminal disclaimer filed 9 August 2004 over Antika et al (6,703,355) has been entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
October 21, 2004